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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/675,614	09/30/2003	Simon Chu	RPS92030112US1	6364

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EXAMINER	
NEWAY, SAMUEL G	

ART UNIT	PAPER NUMBER
2192	

DATE MAILED: 12/11/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/675,614	CHU ET AL.	
	Examiner	Art Unit	
	Samuel G. Neway	2192	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *03 October 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-23 and 25* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-23 and 25* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

1. This is in response to the Amendment filed on October 3, 2006.

2. Claims 1 – 23, and 25 are pending and are considered below.

DETAILED ACTION

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 6, 14, and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6, 14, and 22 are required to determine a physical location of the computer by using a GPS signal. It is unclear how any "executing" can be performed when one of the conditions for executing is that "the computer does not detect a GPS signal" (claim 1, line 11). However, claims 6, 14, and 22 require the computer to receive a GPS signal, thus there is never executing of any software?

Claim Rejections - 35 USC § 102

> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

5. Claims 1, 6, 9, 14, 17, and 22 are rejected under 35 U.S.C. 102(e) as being anticipated by Kyotoku (USPGPub 2003/0110011).

6. As to claims 1, 9 and 17:

Kyotoku discloses a method, system, and product for regulating execution of a software according to a physical location of a computer on which the software is to be executed (see Abstract), the method comprising:

storing a first list of authorized location ranges where a computer is authorized to execute a first software (paragraphs 50, 90);

determining a physical location of the computer (paragraphs 55, 92);

comparing the physical location of the computer with the first list of authorized location ranges (paragraphs 57, 93);

executing the first software only if the physical location of the computer is within a range of one of the authorized location ranges from the first list of authorized location ranges (paragraphs 57, 94, figures 4 and 7); and

executing the first software only if a Global Positioning System (GPS) receiver on the computer does not detect a GPS signal ("installed in a clean room..." where it is difficult for GPS to reach, paragraph 72. If software is downloaded where GPS signal cannot reach (clean room), it is inherent that the downloading is done without the detection of a GPS signal).

As to claim 6, 14, and 22:

Kyotoku discloses the method comprising,

storing a first list of authorized location ranges where a computer is authorized to execute a first software (paragraphs 50, 90);

determining a physical location of the computer (paragraphs 55, 92);

comparing the physical location of the computer with the first list of authorized location ranges (paragraphs 57, 93);

executing the first software only if the physical location of the computer is within a range of one of the authorized location ranges from the first list of authorized location ranges (paragraphs 57, 94, figures 4 and 7); and

wherein the physical location of the computer is determined from a Global Positioning System (GPS) signal (paragraphs 55, 92).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 2 – 3, 10 – 11, 18 – 19, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku (PGPub 2003/0110011) in view of Kraft, IV et al (USPN 6,931,130).

As to claims 2, 10, 18 and 25:

Kyotoku discloses the method of claim 1, but he fails to specifically disclose the method further comprising: upon determining that the physical location of the computer is not within the first list of authorized location ranges, executing a second software.

However, Kraft discloses a similar method where GPS location is used to select and set different encryption levels (different downloads) depending on the physical location of a computer (Abstract, FIG 2, and related text). It would have been obvious to one of ordinary skill in the art at the time the invention was made to request a second or any number of other downloads (different encryption levels based upon the determined geographic location) in Kyotoku's method, as is done in Kraft's method by checking "a value in a look-up table that associates particular encryption levels with specified geographic locations" has been determined (col. 2, line 61 – col. 3, line 14). One would have been motivated to do so because that would enhance the Kyotoku system with an efficient as such "software can be distributed in any geographic region regardless of the region" as once suggested by Kraft (col. 1, lines 15-30)

As to claims 3, 11, and 19:

Kyotoku and Kraft disclose the methods of claims 2, 10, and 18, Kyotoky further discloses upon determining that the computer is not located within an authorized area for the requested software execution, generating an alert ("message") issued to a software administrator server (paragraphs 58, 84).

9. Claims 4 – 5, 7 – 8, 12 – 13, 15 – 16, 20 – 21, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kyotoku in view of Wall (USPGPub 2002/0017977).

As to claims 4, 12, and 20:

Kyotoku discloses the methods of claims 1, 9, 17 but does not disclose specifically rechecking the physical location of the computer and disabling the software

when it is determined that the computer is no longer in an area authorized for executing the software. Wall discloses a similar system to control the use of software utilizing geographic location where the location is continuously checked and the software is enabled only when the computer is located in an authorized area (paragraph 85). It would have been obvious for one with ordinary skills in the art at the time the invention was made to include the continuous checking of Wall's system into Kyotoku's. One would have been motivated to continuously check a computer user's position to control software residing on portable apparatus such as PDAs (Personal Digital Assistant) and laptops.

As to claims 5, 13, and 21:

Kyotoku and Wall disclose the methods of claims 4, 12, 20 but does not disclose specifically deleting the software from the computer's system. Wall discloses a similar system to control the use of software utilizing geographic location where the software is erased from the computer (paragraph 32). It would have been obvious for one with ordinary skills in the art at the time the invention was made to add the feature of erasing the software from the computer's system because that would deter theft and export of software because the software will completely be deleted from the computer if the computer is used outside authorized locations as suggested by Wall ([0013]).

As to claims 7, 15, and 23:

Kyotoku discloses the method of claims 1, 9, and 17 but does not disclose the method wherein the physical location of the computer is determined from a local enterprise generated signal. Wall discloses a similar system to control the use of

software by use of location where "satellites or other alternate paths" are used to determine location (paragraphs 109, 110). It would have been obvious to one of ordinary skill in the art at the time the invention was made to use Wall's other alternative path such as local enterprise generated signal to determine physical location. One would have been motivated to use the local enterprise generated signal to determine location in case it is difficult to use GPS for example where GPS broadcast wave cannot reach a GPS receiver.

As to claims 8 and 16:

Kyotoku and Wall disclose the method of claims 7 and 15, Kyotoku further discloses the method wherein the local enterprise generated signal is confined to a single room ("clean room", paragraph 72).

Response to Amendment

10. The Objection to the Specification, the Claim Objections, and the Claim Rejections under 35 U.S.C 101 have been withdrawn.

11. The Double Patenting has also been withdrawn in view of the Terminal Disclaimer.

Response to Arguments

12. Applicant's arguments with respect to claims 1 and 2 have been considered but are moot in view of the new ground(s) of rejection.

13. Applicant's arguments with respect to claim 5 have been fully considered but they are not persuasive.

Applicant argues that a DLL is not an application, but rather a resource that an application can use (Amendment page 11).

However, both a DLL and an application are executable software and as such represent similar properties as related to the present invention. As executable files, a DLL and/or an application are equivalent in regards to having the ability to be executed when they are located in only authorized locations.

Conclusion

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Samuel G. Neway whose telephone number is 571-270-

1058. The examiner can normally be reached on Monday - Friday 8:30AM - 5:30PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tuan Q. Dam can be reached on 571-272-3695. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

SN

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TUAN DAM
SUPERVISORY PATENT EXAMINER